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10/668,049

09/22/2003

Julie Theel

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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/668,049
Filing Date: September 22, 2003
Appellant(s): THEEL, JULIE

Clement Cheng
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/29/09 appealing from the Office action mailed 1/6/09.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment in the form of an affidavit and other evidence filed after final rejection on 8/28/09 with the appeal brief has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

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| | | |
|-----------|--------------------|--------|
| 5,195,917 | RUSSELL et al. | 3-1993 |
| 3,375,604 | ALONSO | 4-1968 |
| 5,108,100 | ESSEBAGGERS et al. | 4-1992 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 21-25, 28-29, 41-44 and 46-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff (6887120). Shamitoff discloses a toy that could be used by a house pet such as a dog having a main member (112) with an exterior surface (Fig. 2) and an interface surface (128) wherein the main member exterior surface could be non-destructively gripped by a house pet using its mouth and paws since it can be constructed using a plush material or a durable plastic vinyl covering (column 4 lines 51-55). The main member interface surface includes a first portion of a snap connector (128). The toy further includes a secondary member (108) with an exterior surface that could also be non-destructively gripped by a house pet using its mouth and paws since it can also be constructed using a plush material or a durable plastic vinyl covering (column 4 lines 51-55). The secondary member has an interface surface (126) that includes a second portion of a snap connector that can mate with a corresponding first portion of the snap connector on the main member interface surface (Figs. 1-2). The main and secondary members are capable of being shaped and sized to prevent swallowing by a house pet (Fig. 2). The interface surfaces of the main member and the interface surfaces of the secondary members are attachable by a human to create an

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attached toy state via the snap connector which is capable of being non-destructively detached by a house pet using its mouth and paws to create a detached toy state by disconnecting the snap connectors which could then be reattached by a human after being separated (Figs. 1-2). The exterior surfaces main and secondary members would be sufficiently durable to withstand biting and chewing by a house pet due to its vinyl covering. The interface surfaces of the main member and the secondary members are attached securely enough via the snap connectors to require an amount of force to detach the secondary member from the main member (Figs. 1-2). The first portion of a snap connector includes a socket portion (134) and the second portion of a snap connector includes a mating protrusion (130), where the first portion of the snap connector is shaped and sized to snap onto the second portion of the snap connector attaching the main member to the secondary member (Figs. 1-3). The positioning of the snap connector portions can be reversed (column 4 lines 17-24) such that the first portion of the snap connector includes a protrusion (130) and the second portion of the snap connector includes a mating socket portion (134), where the first portion of the snap connector is shaped and sized to snap into the second portion of the snap connector attaching the main member to the secondary member (Figs. 1-3). In regard to the main and secondary members being adapted to teeth of a dog so as to withstand biting, chewing and rending, the examiner notes that that mere selection of known materials on the basis of suitability for the intended use would be entirely obvious. See *in re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Shamitoff with a material adapted for teeth of a

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dog so as to withstand biting, chewing and rending in order to use known materials suitable for the intended use. Also in regard to the main and secondary members being adapted to the teeth of a dog in terms of size, the examiner notes that a mere change in the size of a component would be obvious to one of ordinary skill in the art. *See In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff and Russell (5195917). Shamitoff discloses the basic inventive concept substantially as claimed with the exception of the main and secondary members being attached using hook and loop fasteners. Russell discloses a figure toy having separable parts held together with hook and loop fasteners (column 1 lines 27-37). It would have been obvious to one of ordinary skill in the art from the teaching of Russell to have the parts connected with hook and loop fasteners since it would provide an easy and simple means of connecting and disconnecting a toy figure. Furthermore, since both references teach methods for connecting elements of a toy, it would have been obvious to one skilled in the art to substitute one element for the other in order to achieve the predictable result of connecting the elements in a non-permanent manner.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff and Alonso (3375604). Shamitoff discloses the basic inventive concept substantially as claimed with the exception of the main and secondary members being attached using magnets. Alonso discloses a figure toy having separable parts held together with magnetic means (abstract). It would have been obvious to one of ordinary skill in the art from the teaching of Alonso to have the parts connected with magnets

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since it would provide an easy and simple means of connecting and disconnecting a toy figure. Furthermore, since both references teach methods for connecting elements of a toy, it would have been obvious to one skilled in the art to substitute one element for the other in order to achieve the predictable result of connecting the elements in a non-permanent manner.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff and Essebaggers (5108100). Shamitoff discloses the basic inventive concept, substantially as claimed, with the exception of a cord connecting the interference surfaces of the members. Essebaggers discloses connection elements having interface surfaces (Fig. 6) for connecting the elements together (column 2 lines 27-32) connected by a cord (Fig. 5). It would have been obvious to one of ordinary skill in the art from the teaching of Essebaggers to connect the elements of Shamitoff with a cord in order to ensure that the elements remain together and the device will stay complete (column 2 lines 21-26). It would have been obvious to have the cord connecting at the interfacing surfaces, since such a modification would involve a mere rearrangement of parts. A rearrangement of parts is generally recognized as being within the level of ordinary skill in the art. *See In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).*

Claims 45, 58 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff. The references disclose the basic inventive concept, with the exception of the toy being constructed of rubber or polyethylene material. The examiner notes that mere selection of known materials as recited in claims 45, 58 and 62 on the basis

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of suitability for the intended use would be entirely obvious. *See in re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art to provide Shamitoff with the materials recited in the claims in order to use known materials suitable for the intended use.

Claims 55-57 and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamitoff. Shamitoff discloses the basic inventive concept, substantially as claimed with the exception of disclosing the size of the components as to whether it could prevent swallowing by a large dog. It would have been an obvious matter of design choice to make the device sized so as to prevent swallowing by a large dog, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *See In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

(10) Response to Argument

In response to Applicant's argument that Shamitoff is not a dog toy, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In regard to Applicant's arguments that changing the size or material used in the Shamitoff reference would change the operation of the device, the examiner notes that changing the material or size of the components would in no way hinder the ability of the Shamitoff reference to function as a toy with a main member and secondary

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members that can be repeatedly attached and detached from one another, and that modifications with regard to materials and size have long been held to be within the level of ordinary skill in the art.

In regard to Applicant's argument that Shamitoff teaches away from a pet toy since it discloses an embodiment (Fig. 5) in which small portions such as the eyes, ears, earrings, nose, mouth, mustache, beard and hair can be removed from the toy. However, the examiner notes that it has been held that disclosed examples do not constitute a teaching away from a broader disclosure and in the case of Shamitoff an embodiment (Fig. 2) is disclosed where only the larger members are separable from the toy. *See In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).*

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Alyssa M Hylinski/

Examiner, Art Unit 3711

Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

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Supervisory Patent Examiner, Art Unit 3715